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PTH

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SEPT 4, 97

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Geoffrey, Inc.

v.

Floors 'R' Us, Incorporated

Opposition No. 90,662
to application Serial No. 74/74/279,806
filed on June 1, 1992

Roberta S. Bren of Oblon, Spivak, McClelland, Maier &
Neustadt, P.C. for Geoffrey, Inc.

Carl Ferguson for Floors 'R' Us, Incorporated, pro se.

Before Rice, Quinn and Hairston, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

Floors 'R' Us, Incorporated has filed an application to
register the mark depicted below,



for "retail and wholesale stores featuring flooring."¹

Registration has been opposed by Geoffrey, Inc. on the grounds that since well prior to applicant's date of first use, opposer and its predecessor in interest have sold a wide range of items and rendered a variety of services under the marks TOYS "R" US and KIDS "R" US and other marks comprising "R" US; that opposer is the owner of a family of "R" US marks; and that applicant's mark, when used in connection with its services, so resembles opposer's previously used and registered marks for its products and services as to be likely to cause confusion, mistake or deception. Opposer has pleaded ownership of a number of registrations for its marks.²

¹Application Serial No. 74/279,806, filed June 1, 1992, alleging dates of first use and first use in commerce of March 1990. The words "FLOORS", "CERAMIC & VINYL TILE", "WOOD FLOORS", and "CARPETING" have been disclaimed apart from the mark as shown.

²Registration No. 902,125 (TOYS "R" US) for a general line of children's toys and toy novelties, issued November 10, 1970, renewed; Registration No. 1,215,353 (TOYS "R" US) for retail department store services, issued November 2, 1982, Sections 8 & 15 affidavit filed; Registration No. 1,270,000 (KIDS "R" US, KIDS is disclaimed) for wearing apparel-namely, polo shirts, sweat shirts, jeans, shorts, short sets, swimwear and hosiery for infants, toddlers, girls and boys, issued March 13, 1984, Sections 8 & 15 affidavit filed; Registration No. 1,399,419 (TOYS "R" US) for, inter alia, luggage, umbrellas, dishes, yarns, blankets, comforters, wash cloths, childrens costumes, earrings, shoe laces, issued July 1, 1986, Sections 8 & 15 affidavit filed; Registration No. 1,405,363 (SHOES "R" US, SHOES is disclaimed) for retail shoe store services issued August 12, 1986, Sections 8 & 15 affidavit filed; Registration No. 1,405,364 (PORTRAITS "R" US, PORTRAITS is disclaimed) for photography services, issued August 12, 1986, Sections 8 & 15 affidavit filed; Registration No. 1,407,192 (BIKES "R" US, BIKES is disclaimed) for retail bicycle store services, issued August 26, 1986, Sections 8 & 15 affidavit filed; Registration No. 1,413,778 (COMPUTERS "R" US, COMPUTERS is disclaimed) for retail computer store services, issued October 14, 1986, Sections 8 & 15 affidavit filed; Registration No. 1,473,595 (MATHEMATICS "R"

Applicant, in its amended answer, admits that opposer is the owner of the pleaded registrations. Also, applicant admits that the parties' marks are similar in sound and that there is some similarity in trade channels and customers. Applicant, however, denied the remaining allegations of the notice of opposition.

The record consists of the testimony depositions (with exhibits) of opposer's witnesses Ernest Speranza and Ellen Storch; copies of opposer's pleaded registrations and two additional registrations introduced during the deposition of Ms. Storch³; and opposer's notice of reliance on (1) applicant's answer to an interrogatory and (2) portions of the discovery deposition of applicant's president, Carl Ferguson.⁴

US, MATHEMATICS is disclaimed) for entertainment services in the nature of a television program issued January 19, 1988, Sections 8 & 15 affidavit filed; Registration No. 1,531,202 (TOYS "R" US) for insurance services, namely underwriting services, issued March 21, 1989, Sections 8 & 15 affidavit filed; and Registration No. 1,554,261 (KIDS "R" US) for retail department store services, issued August 29, 1989, Sections 8 & 15 affidavit filed. Each of the marks in the above registrations is depicted in stylized letters and the "R" is reversed.

³Registration No. 1,774,543 (BOOKS "R" US, BOOKS is disclaimed) for retail book store services, issued June 1, 1993; and Registration No. 1,781,456 (PARTIES "R" US, PARTIES is disclaimed) for key rings, hair combs, balloons, yo-yo's, flying discs, noisemakers, jump ropes, toy vehicles and dolls issued July 13, 1993. Inasmuch as applicant has not objected to the additional registrations, they are considered of record. Ms. Storch testified that the pleaded registrations as well as the additional registrations are valid and subsisting and currently owned by opposer.

⁴Although applicant submitted a notice of reliance, the notice was untimely. See the Board's July 16, 1996 order. As indicated in that order, the materials accompanying the notice do not form part of the record of this case and have not been considered in reaching our decision. We hasten to add that,

The case has been fully briefed. Opposer's counsel and applicant's president appeared at the oral hearing before the Board.

The record shows that opposer, through its TOYS "R" US stores, primarily sells toys, games, books; baby products such as strollers, car seats, and diapers; and childrens' clothing. In addition to these items, opposer sells desks, bean bags, tents, lamps, mirrors, humidifiers, book cases, play pools and gyms. The first TOYS "R" US store was opened in Texas in 1960 and each store is arranged in sections, bearing designations such as MOVIES "R" US, BOOKS "R" US, and BIKES "R" US. Opposer's business has grown rapidly and in 1983 opposer opened its first children's clothing store, KIDS "R" US. Each KIDS "R" US store is arranged in sections, bearing designations such as GUYS "R" US, GALS "R" US, and TYKES "R" US. Opposer currently operates more than 600 TOYS "R" US stores and more than 200 KIDS "R" US stores in the United States. Among the other services opposer offers under marks comprising "R" US are trucking, real estate and educational services. Opposer advertises by direct mail, on television and radio, in newspapers, and in publications ranging from parenting magazines to Popular Mechanics.

Over the years, opposer has promoted its goods and services through tie-ins with toy and food manufacturers, banks,

even if we had considered these materials, our decision herein would be the same.

amusement parks and automobile dealerships. Opposer has spent millions of dollars in advertising. For example, in 1994, opposer spent over \$225 million and opposer's net sales for the same year were in excess of \$7 billion. Opposer has vigorously policed its marks by way of cease and desist letters and civil actions.

The little information we have about applicant comes from its interrogatory response and portions of the discovery deposition of its president, Mr. Ferguson. Mr. Ferguson testified that he has been in the flooring business "[o]ff and on part-time since 1964." (Deposition, p. 131). Applicant opened a retail store in Houston, Texas in 1991 under the name Carpet Designs by Carl and subsequently changed the name to FLOORS R US. The store was located only two blocks from a TOYS "R" US store. At the discovery deposition, opposer's counsel asked Mr. Ferguson about the selection of the name FLOORS 'R' US.

Q. How did you come up with the name Floors
'R' Us?

A. I felt like it would be a good name.

Q. Why was that?

A. No particular reason. I just felt like
it would be a good name.

(Deposition, p. 28).

As of the date of the discovery deposition applicant was not operating a store. According to Mr. Ferguson, applicant's customers include homeowners, apartment owners,

builders, and contractors. Among the promotional items which applicant has given to customers are key rings and fountain pens.

There is no question as to priority in view of opposer's ownership of valid and subsisting registrations of its marks. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

This brings us to the issue of likelihood of confusion. Our determination of this issue must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

It is opposer's position that by virtue of its extensive use of marks comprising "R" US for a variety of goods and services, it has a family of such marks; that these marks are famous; that applicant's mark is very similar to opposer's marks; and that applicant's services are related to opposer's goods and services.

The Court of Appeals for the Federal Circuit has defined a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is

indicative of a common origin of the goods... Recognition of a family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991). Further, the Board has in the past required the following:

In order to establish a "family of marks," it must be demonstrated that the marks asserted to comprise its "family" or a number of them have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

American Standard Inc. v. Scott & Fetzer Co., 200 USPQ 457, 461 (TTAB 1978). Further, a party must show that the 'family' feature is distinctive. Marion Laboratories Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215 (TTAB 1988).

Opposer has submitted evidence of advertising, promotion and use of two or more of its marks conjointly in a manner calculated to impress upon the relevant purchasers that "R" US marks used in opposer's businesses indicate source in opposer. For example, this record includes a copy of a photograph of a TOYS "R" US store with banners hanging therein designating the BOOKS "R" US, PARTIES "R" US and MOVIES "R" US sections; a TOYS "R" US circular with an invitation to visit the BOOKS "R" US section of the store; copies of two TOYS "R" US catalogs featuring bicycles under the designation BIKES "R" US and games under the designation

GAMES "R" US; and several KIDS "R" US CATALOGS featuring girls and boys clothing under the designations GALS "R" US and GUYS "R" US, respectively. This evidence leads us to conclude that opposer has a family of "R" US marks.⁵ Contrary to applicant's argument, there is no evidence that "R" US is descriptive or highly suggestive of any of opposer's goods or services. Moreover, there is no requirement, as applicant maintains, that each of the marks relied on by opposer as part of its family be registered.

Further, this record establishes that opposer's family of "R" US marks is strong and well-known. It is well settled that a well-known or famous mark is entitled to a broader scope of protection than one which is relatively unknown. That is because the issue in an opposition proceeding such as this is whether, because of the marks used on the involved goods/services, there will be confusion, mistake or deception as to the source of those goods, and confusion is more likely to occur where a mark is very well-known or even famous because there is a propensity of consumers to associate a little-known mark with one which is familiar to them. See *Fruit of the Loom v. Fruit of the Earth, Inc.*, 3 USPQ2d 1531 (TTAB 1987) and *Miles Laboratories v. Naturally Vitamin Supplements*, 1 USPQ2d 1445 (TTAB 1987).

⁵In this regard, we note that the U.S. District Court for the Central District of California also recently found that opposer had a family of "R" US marks. See *Geoffrey, Inc. v. Stratton*, 16 USPQ2d 1691, 1694 (D.C. CA 1990).

With the foregoing in mind, we turn to a comparison of the parties' marks. We agree with opposer that the marks are very similar. Applicant has admitted that the marks are similar in sound. Moreover, the word portion of applicant's mark and opposer's marks follow the same pattern - a generic or highly descriptive term followed by "R" US. In considering the marks, we have given more weight to the "R US" portion of opposer's and applicant's marks because of the generic/highly descriptive nature of the remaining portions of the marks. In re National Data Corp., 753 F.2d 1056, 24 USPQ 749 (Fed. Cir. 1985). It is the "R" US portion of each party's mark that is more likely to be remembered by consumers. In short, when the marks are compared in their entireties, they are similar in sound and convey the same commercial impression.

As for the goods/services, there is no question that opposer's goods and services are different from applicant's services. Nonetheless, we find that there is a likelihood that consumers will be confused into believing that applicant's retail and wholesale stores featuring flooring are somehow sponsored by or associated with opposer.

It is well settled that goods/services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods/services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be encountered by the

same persons under circumstances that would give rise to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, the products offered for sale by applicant (e.g., carpeting and vinyl tile) and many of the products offered for sale by opposer in its stores (e.g., lamps, desks, bean bags, and book cases) would be used in decorating or furnishing a child's bedroom or play room. As applicant admits in its answer, some of the customers of applicant's retail and wholesale stores featuring flooring are also customers of opposer's goods and services. Such customers may well believe that opposer has expanded its line of products and services to include retail and wholesale stores featuring flooring. As to applicant's contention that purchasers of its services are sophisticated, there is no support for this contention in the record.

Taking all the factors, as discussed above, we conclude that consumers familiar with opposer's family of "R" US marks, who then encounter applicant's very similar mark, FLOORS "R" US and design, used in connection with retail and wholesale stores featuring flooring, are likely to believe that these services are sponsored by or affiliated with opposer.

In reaching this decision, we have kept in mind that preference is accorded the prior user of a mark or a family of marks as against a newcomer. The newcomer has a duty to avoid confusion with well-known marks of others. See Specialty Brands Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 676, 223 USPQ 1281, 1285 (Fed. Cir. 1984).

Decision: The opposition is sustained and registration to applicant is refused.

J. E. Rice

T. J. Quinn

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial and
Appeal Board